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Supreme Court of the United States

OCTOBER TERM, 1934.

DOCKET NO. 102

SAMUEL B. SMITH,

Petitioner,

vs.

E. H. SNOW, AND E. H. SNOW DOING BUSINESS AS SNOW'S HATCHERIES AND SNOW'S INCUBATOR CO., *Respondents.*

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

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RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

SECTION I.

DECISIONS BELOW.

The suit is an action in equity for the alleged infringement of the method claims 1 and 2 of the U. S. Letters Patent No. 1,262,860, granted to the petitioner, Samuel B. Smith, April 16th, 1918, entitled "Incubator." A copy of this patent appears in the record (R. 425).

The suit was brought in the Fourth Division of the U. S. District Court, District of Minnesota. Trial was had before district judge Joseph W. Molyneaux, and, on February 7th, 1933, he signed and filed his decision therein (R. 20); and, on February 11th, 1933, he signed and filed the interlocutory decree of said trial court (R. 24). Said trial court's decision has not been reported.

In said trial court's decision and decree, it was held and decreed that said relied-upon claims 1 and 2 of said Smith patent 1,262,860, were valid and had been infringed.

From the said trial court's said decree, the respondents appealed to the Circuit Court of Appeals for the 8th Circuit. The Appeal hearing was before Circuit Judges Stone and Sanborn and District Judge Wyman.

At the said Appeal hearing, the commercial specimens of the patented Smith machine and of the respondent's machine introduced into evidence, as exhibits, at the trial of the case in the District Court, were set up in the court room of the Circuit Court of Appeals in St. Louis and operated (without eggs) in the presence of said judges of said Court.

The decision of the said Circuit Court of Appeals for the 8th Circuit was filed April 12, 1934, is reported in 70 F. R. (2) 564, and appears in the record (R. 984). The decree of said Circuit Court of Appeals was dated and filed April 14th, 1934, and appears in the record (R. 991).

In its said decision and decree, the said Circuit Court of Appeals held and decreed that the said relied-upon claims 1 and 2 of said Smith patent 1,262,860, in suit, were valid but had not been infringed; and, in its said decree, said Court of Appeals reversed the decree of said trial court and ordered the bill of complaint to be dismissed.

Petition for rehearing was filed by the appellee in that case (the petitioner here) April 30th, 1934, and this was denied in an order of said Court of Appeals dated and filed May 5th, 1934 (R. 1005).

SECTION II.

SUBJECT MATTER. PATENT CLAIM QUOTED.

The Smith patent 1,262,860, in suit, purports to disclose "an improved apparatus and method" for hatching eggs in large quantities. The drawings illustrate and the specification describes a machine which constitutes the apparatus referred to in the first sentence of the second paragraph of the specification. In substance, it is represented or implied, that in the operation of this machine or apparatus, the alleged improved method of hatching eggs is carried into effect.

The Smith patent, instead of relating to a new and revolutionary process of incubation, which petitioner alleges, relates, at most, to a very limited and narrow improvement in a crowded and highly developed art. This is so well established by the prior adjudications of the Smith patent that no further comment on this point is deemed necessary.

Said Smith patent contains five claims, the first three of which relate to the alleged method of hatching a plurality of eggs and the other two of which relate to the apparatus or machine. Only the first of the said three method claims is here involved; and said claim 1 of said patent reads as follows:

> "1. The method of hatching a plurality of eggs by arranging them at different levels in a closed chamber having restricted openings of sufficient capacity for the escape of foul air without undue loss of moisture and applying a current of heated air, said current being created by means other than variations of temperature and of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber at substantially the same temperature, whereby the air will be vitalized,

the moisture conserved and the units of heat will be carried from the eggs in the more advanced stage of incubation to those in a less advanced stage for the purpose specified."

The statement of the disclosure of the Smith patent made by Judge Stone in the decision of the C. C. A. for the 8th Circuit in the instant or Snow case is so clear and correct that no further detailed description thereof is here needed.

Respecting the circulation of the air, when the Smith incubating machine is in operation, however, one highly important additional fact should be noted in view of what is said on pages 8 and 9 of the petition.

In those statements it is implied that the same air is recirculated through the incubating chambers of the Smith machine in repeated cycles in the same condition. That implication is absolutely groundless. In the usage of the Smith machine, *no air is ever recirculated in the same condition.* Fresh air is being constantly sucked in to the air conditioning chamber of the machine, under the action of the fans, and a corresponding amount of used air is constantly being discharged through outlets located above the tiers of egg trays. In every cycle, the used air not discharged meets and is commingled with fresh air sucked in by the fans, and the whole of said mixed old and fresh air is moistened and heated before it reaches the eyes of the fans. The discharged air carries out with it enough of the carbon dioxide emitted by the eggs to prevent harmful accumulation thereof, and the fresh air drawn in supplies the necessary oxygen required for the incubating chicks.

In other words, it is this interchange and conditioning of the air during each cycle that vitalizes the whole composite body of air which is circulated through the corridor and

the tiers of egg trays in the Smith machine. It is this air that is revitalized and heated during each cycle that first strikes the eggs in the advanced stages of incubation and then moves onto the eggs in the earlier stages of incubation.

SECTION III.

THE ALLEGED CONFLICTING DECISIONS.

In the petition, it is alleged that the above identified decision of the U. S. Circuit Court of Appeals for the 8th Circuit, in the instant or Snow case, conflicts with each of three other earlier decisions of other United States Circuit Courts of Appeal, wherein claim 1 of this same Smith patent, 1,262,860, was adjudicated, to-wit:

(a) *Waxham vs. Smith, et al.,* decided by the Circuit Court of Appeals for the 9th Circuit, April 9th, 1934, reported in 70 F. R. (2) 457, and printed as an appendix to the petition (pp. 26 to 35).

(b) *Buckeye Incubator Co., et al., vs. Blum,* decided by the Circuit Court of Appeals for the 6th Circuit, July 6th, 1928, and reported in 27 F. R. (2) 333. The trial court's decision in said Blum case is reported in 17 F. R. (2) 456.

(c) *Buckeye Incubator Co., et al., vs. Hillpot,* decided by the 3rd C. C. A., Feb. 10th, 1928, and reported in 24 F. R. (2) 341. The trial court's decision in said Hillpot case is reported in 22 F. R. (2) 855.

SECTION IV.

THE PETERSIME CASE.

The title of this case in the Circuit Court of Appeals for the 6th Circuit was *Buckeye Incubator Co., et al., vs. Petersime, et al.* It was decided June 10th, 1927, and is reported in 19 F. R. (2) 721.

In the petition, page 3 thereof, it is stated, in substance, that the holding made by the 6th Circuit Court of Appeals in said Petersime case was the same as the holding made by the 8th Circuit Court of Appeals in the instant or Snow case.

SECTION V.

PRIOR ADJUDICATIONS OF THE SMITH PATENT 1,262,860 IDENTIFIED IN THE APPENDIX.

All of the contested prior adjudications of the Smith patent 1,262,860, in suit, wherein the method claim 1 thereof, was in issue, with the exception of the Waxham case in 9th C. C. A., are identified in the appendix to this brief, arranged in the order of the dates of the trial court's decisions, and accompanied by sufficient comment to make clear which thereof are pertinent and which thereof are non-pertinent, as to the question of the true meaning and scope of claim 1 of said Smith patent.

If these prior decisions be inspected and considered, it will be seen that there are only three prior adjudications reaching Circuit Court of Appeals which are of any controlling weight as to the true meaning and scope of said claim of said patent, to-wit, the adjudications in said Petersime case, in said Blum case and in said Hillpot case hereinbefore specifically identified.

SECTION VI.

JURISDICTION.

Respondents admit the jurisdiction of the Court.

SECTION VII.

THE RESPONDENTS' CONTENTIONS.

The respondents deny each and all of the "Reasons Relied on For Allowance of Writ" set forth on pages 14 to 17, inclusive, of the petition and deny each and all of the "Assigned Errors" specified on page 20 and argued about on pages 21 to 25, inclusive, of the petitioner's brief; and respondents make the hereinbelow identified contentions in opposition to the granting of said petition, to-wit:

CONTENTION NO. 1—AS TO SPECIFIC QUESTION PRESENTED IN PETITION.

The petition is fatally defective on its face.

The specific question submitted on page 6 of the petition reads as follows (italics ours):

> "Does an *infringer* avoid claim 1 of the patent by arranging the eggs *in a different order*, or by omitting the shifting of the eggs during the first eighteen days of incubation?"

A. By the usage of the word, "infringer," in the said question, it is obvious that only a moot question is presented. The question presupposes an infringement of the patent and as a result the desired answer is assumed or begged in the question itself. The Supreme Court does not pass on moot questions.

B. After presupposing an infringement, it is asked whether claim 1 of the patent would be avoided by arranging the eggs "in a different order." What is meant by "in a different order"? This expression must mean in a different order than the order disclosed in the patent; and, if so, the assumed method of incubation, including the step of arranging the eggs in a different order, is necessarily outside of the scope of the claim of the patent for lack of disclosure of the subject matter in the patent.

C. Even if the Supreme Court should find that arranging the eggs in a different order than that disclosed in the patent and omitting shifting of the eggs during the first eighteen days of incubation would not avoid infringement of the Smith patent, still there would be no basis for the issuance of the prayed-for writ; for this would not of itself be determinative of the correctness of the holding of the Circuit Court of Appeals of the Eighth Circuit on the question of infringement.

Non-infringement was found in the instant or Snow case on several grounds: One of these grounds was that claim 1 of the patent is limited by the disclosure in the patent to a method of incubation wherein an air current is used and this air current is a column of air passing through a column of eggs in a definite direction. The said Court found *as a fact* that in respondents' method of incubation there was no such air current. The Court's own language is as follows, appearing on page 568 of the reported case, to-wit:

> "As to the air currents, the arrangement is different. The conception and operation of appellee's device is a column of air passing through the column of eggs in a definite direction—from eggs in advanced stages to those less advanced. In appellants' device, the concep-

tion and operation is a wide, general diffusion of air kept moving around all of the eggs without relation—as to direction—to the location of eggs in particular stages of incubation. In fact, the arrangement of eggs by appellants could not permit of such directioning of air currents.

Thus differing in both essentials of the patent—arrangement of eggs and air current—from the device disclosed by the patent, appellants' device is not infringing."

CONTENTION NO. 2—AS TO THE ALLEGED CONFLICT BETWEEN THE EIGHTH AND NINTH CIRCUITS.

The decision of the Circuit Court of Appeals for the Eighth Circuit in the instant or Snow case does not conflict with the decision of the Circuit Court of Appeals for the Ninth Circuit in the case of *Waxham vs. Smith, et al.,* for the controlling reason that the differences between the two decisions do not involve any material questions of law but turn primarily on questions of fact.

In the Waxham case, the Circuit Court of Appeals for the Ninth Circuit did not undertake to determine the true meaning and scope of claim 1 of the Smith patent in suit when construed in the light of the disclosure of the patent and distinguished from the prior art and the estoppels arising from the file-wrapper record of the patent; but, on the contrary, said Court expressly stated that it made no attempt to determine this question. In the paragraph of said Court's decision beginning near the bottom of page 458 of the reported case, the Court first identified several of the prior adjudications of the Smith patent in suit and then, among

other things, made the following statement on page 459 (italics ours), to-wit:

> "In view of the decisions above referred to, interpreting the Smith patent, we deem it unnecessary to further discuss either the *nature or character of the invention* or to *describe the method of incubation covered by the Smith patent* or to attempt to define the *limitations placed upon the patent* by these decisions, which, in that regard are not entirely consistent."

The differences between the controlling facts in the instant case, and in the Waxham case may best be brought out by comparing statements of the Courts in the two cases in parallel columns:

The Eighth Circuit in the instant or Snow case. 70 F. R. (2d) 568.	*The Ninth Circuit in the Waxham case.* 70 F. R. (2d) 460.
"Appellants' device is based on an entirely different method. As to arrangement of eggs, it mixes up those in various stages of incubation —not in the same tray but as to trays, there is no part of the egg column set aside to eggs in a particular stage but trays of eggs in one stage are layered in with trays in other stages in a predetermined order. Another difference is that a tray is never moved when once placed in the col-	"There is a definite and continuous current of air utilized in the Waxham device moving at a velocity not materially different from the speed of the air current in the Smith patent, and accomplishing substantially the same purpose."

umn. As to the air currents, the arrangement is different. The conception and operation of appellee's device is a column of air passing through the column of eggs in a definite direction—from eggs in advanced stages to those less advanced. In appellants' device, the conception and operation is a wide, general diffusion of air kept moving around all of the eggs without relation—as to direction—to the location of eggs in particular stages of incubation. In fact, the arrangement of eggs by appellants could not permit of such directioning of air currents.

Thus differing in both essentials of the patent—arrangement of eggs and air current—from the device disclosed by the patent, appellants' device is not infringing."

From the above it will be seen that the Eighth Circuit in the Snow case found as a fact that there was no general current movement of air in the Snow machine, but, on the contrary, there was merely a general diffusion of the air. On the other hand, the Ninth Circuit in the Waxham case found

as a fact that there was a definite and continuous current of air used in the Waxham machine substantially the same as that of the Smith patent. These respective basic facts determined by the Circuit Courts of Appeals in the two different Circuits led the Eighth Circuit to declare that the patent was not infringed and led the Ninth Circuit to declare that the patent was infringed.

It is not denied but that the two Courts in the Eighth and Ninth Circuits took slightly different views as to the scope of claim 1 of the Smith patent but these differences were immaterial to the question of infringement in view of the wide differences between the respective status of fact in the two cases. There is no sufficient conflict between the two Circuit Courts of Appeals in the Eighth and Ninth Circuits to warrant issuance of the writ.

The situation is similar to that which existed in *Layne & Bowler Corporation vs. Western Well Works, Inc., et al.*, 261 U. S. 387, wherein a writ of certiorari had been granted for alleged conflict of decisions but wherein, at the hearing, it developed that there was no real conflict and the case was dismissed on the ground that the writ of certiorari had been improvidently granted.

CONTENTION NO. 3—AS TO THE ALLEGED CONFLICT BETWEEN THE EIGHTH AND SIXTH CIRCUITS—RE BLUM CASE.

There is no conflict, whatever, between the decision of the Circuit Court of Appeals for the 8th Circuit in the instant or Snow case, and the decision of the Circuit Court of Appeals for the 6th Circuit in the case entitled, *Buckeye Incubator Co., et al. vs. Blum*, decided July 6th, 1928, and reported in 27 F. R. (2) 333.

In this Blum case, the said Circuit Court of Appeals for the 6th Circuit affirmed the decision of the trial court, Judge Westenhaver, rendered February 14th, 1927, and reported in 17 F. R. (2) 456. Judge Westenhaver, in his decision, very carefully considered the disclosure of the Smith patent, the disclosures of the prior art and the estoppels arising from the file wrapper record of the Smith patent in suit, with a view of determining the true meaning and scope of the method claims 1 and 2 of the Smith patent there in suit and his conclusion was summarized in the following paragraphs taken respectively from page 461 and page 462 of the reported case:

> "Smith is not now entitled to have a construction which covers merely eggs in different stages of incubation in one chamber, with heated air applied to or forced about them. He made an effort to get claims broad enough to admit of this construction, and failed. He acquiesced in that rejection and accepted claims which called for the application of a current of air. This expression, whether we consider merely its normal meaning, or whether we determine its meaning from the disclosures of the specifications, or whether we determine the same from these repeated Patent Office rejections, must be held limited to a method which calls for the creation and driving by force of a current of air in some more or less definite or predetermined direction through a column of eggs arranged in an order which presents first to the current those in the most advanced stage. In my opinion, defendant has not appropriated this element or step of claim 1, and is not guilty of infringement. * * *
>
> "I still think that defendants" (machine) "has many

> limitations and disadvantages. Be that, however, as it may, its method is not Smith's invention, nor the method called for by the words in claim 1 'applying a current of air.' Even if Smith's invention is one of great merit, and his patent claims entitled to a liberal range of equivalents, it is not permissible to give those claims a construction broad enough to include a method which does not use or apply his current of air."

The Circuit Court of Appeals for the 6th Circuit affirmed said trial court's decree on the grounds stated in the last of the above quoted paragraphs of Judge Westenhaver's decision, without passing on the question of whether or not in the usage of the machine of the Smith patent, the heated current of air must first strike the eggs in the most advanced stage and then later pass to the eggs in earlier stages of incubation.

The hearing before the Circuit Court of Appeals for the 6th Circuit in the Blum case occurred July 6th, 1928, or several months subsequent to the decision of the 3rd Circuit Court of Appeals in the Hillpot case which was decided February 3rd, 1928, and the dictum appearing in the decision of the Hillpot case, written by Judge Wooley, was obviously called to the attention of the judges of the 6th Circuit Court of Appeals in the Blum case with a request that said 6th Circuit should modify its holding made in the Petersime case. The said 6th Circuit Court did not pass on the question whether its reasoning in the Petersime case was defective or not, but simply placed its affirmance of the trial court on the ground that the defendant in the Blum case did not use the current of air called for in the relied-upon method claims of the Smith patent.

On page 3 of the petition it is alleged that the Sixth Cir-

cuit Court of Appeals, in its decision in the Blum case, *receded* from its holding earlier made in the Petersime case, 19 F. R. (2d) 721, and expressed a view conforming to the views of the Ninth Circuit Court of Appeals in the Waxham case. This statement is repeated in petitioner's brief (p. 23). Said statements are not correct, but, on the contrary, are groundless. Said Court in said Blum case simply refused to pass on whether or not the method claims 1 and 2 of said Smith patent were limited to a circulation of air wherein the air current first strikes the eggs in the advanced stages of incubation and thereafter passes onto eggs in earlier stages of incubation.

The decision itself is short but makes the above stated facts distinct.

After referring to the assumed defect in its reasoning in the Petersime case, said Court (pp. 334, 335) made the following statement:

> "We think we need not consider the effect of this defect in the reasoning—if it is a defect—of our former opinion. The result in that case rests also upon the theory that the patent contemplates a distinct, or at least an identifiable, current of air flowing like a stream in one direction. Upon reconsideration, we are satisfied that this theory is correct. Whether there is such a fairly distinct current, as distinguished from the general agitation employed by the defendant here, and in less degree by the defendant in the Petersime case, is said to be of no practicable importance in achieving the successful result. Perhaps so; and yet dependence upon that theory in order to sustain the patent, is required, both by the proceedings in the Patent Office and by the prior art, including Smith's too old public use. Smith

learned or knew he must differentiate in this respect in order to get his patent.

The decree below is affirmed."

It will be seen from the foregoing quotation that the Sixth Circuit Court of Appeals in the Blum case affirmed the trial court's holding of non-infringement on the ground that Blum did not employ the current of air called for in claim 1 of the Smith patent. In other words, that Court of Appeals grounded its finding of non-infringement on one of the same identical grounds on which non-infringement by the respondent was founded in the instant case by the C. C. A. of the Eighth Circuit.

In other words, the decision of the Circuit Court of Appeals for the 6th Circuit in the Blum case instead of conflicting is in harmony with the decision of the 8th Circuit in the instant or Snow case.

CONTENTION NO. 4—AS TO THE ALLEGED CONFLICT BETWEEN THE 8TH AND 3RD CIRCUITS.

There is no conflict whatever between the holdings made by the C. C. A. of the 8th Circuit in the Snow case and the holdings made in the C. C. A. of the 3rd Circuit in the case entitled, *Buckeye Incubator Co., et al. vs. Hillpot*, decided Feb. 10, 1928, and reported in 24 F. R. (2d) 341.

The portions of said decision in the 3rd C. C. A. of the Hillpot case quoted on pages 10 to 12, inclusive, of the petition are mere *dicta*, and, in effect, were stated so to be directly in the decision itself. In the very next paragraph appearing on page 344 of the reported case, said Court made the following statement (italics ours):

"But the issue of infringement in this case does not

turn in law on such an interpretation of the claims alone, or in fact on what, as thus far stated, seems a mere reversal of the steps of the patented methods. *It turns on another fact, until now purposely omitted, and on its consequent air movement.* Looking for the invention by reading the claims in the light of the specification and the file-wrapper history of the patent prosecution, one fixed and definite thing is disclosed, first, with reference to its presence in the apparatus and next with reference to its use in the methods. That is a 'corridor' between tray tiers, and a corridor of a kind defined by its purpose. The specification describes this by saying:

'The invention comprises a wall chamber * * * subdivided longitudinally by two parallel rows of curtains *3* and *4* to provide a central compartment or corridor *5* and said compartments *6* and 7' (tray tiers).

This physical arrangement is provided specifically to perform the function of maintaining and directing the air current created by the motor-driven fan. Without such an arrangement the air would go where it pleased. With such an arrangement the air, confined in a corridor partitioned from the tray tiers by curtains, will move in a current or column to the point of outlet which usually is at the bottom of the corridor, when, after mushrooming, it will pass below the tiers and ascend through the egg trays in a current or column because it is confined there by the same curtains that first prevented its escape from the corridor. *The essence of the invention therefore is forced circulation of heated air in predetermined direction, or, stated differently, forced circulation of columns of heated air through columns of eggs.* * * * Yielding to the demands of the Patent

> Office that the 'circulation of air shall be included and defined,' Smith acquiesced in repeated rejections of his claims, proposed others and finally accepted those allowed, in each of which is embodied the conception of air movement by currents in defined channels."

Then after comparing the air circulation in the Smith and Hillpot machines, the said Court (p. 345) expressed its conclusion as follows:

> "We are constrained to find that Hillpot did not infringe the claims of the Smith patent in suit."

From the foregoing quotations, it will be seen that in the Hillpot case the said 3rd Circuit Court of Appeals placed its holding of non-infringement on one of the identical grounds that non-infringement was declared by the C. C. A. for the 8th Circuit in the instant or Snow case. In other words, the holdings of the said two Courts are harmonious.

SECTION VIII.

CONCLUSION.

It is respectfully submitted that, in the foregoing portions of this brief, it has been conclusively shown (1) that the petition is fatally defective on its face and (2) that no conflict on any material question of law exists between the decision of the 8th Circuit Court of Appeals in the instant or Snow case, and any of the other alleged conflicting decisions of other Circuit Courts of Appeals identified in said petition.

In other words, the respondents have shown that the petitioner's alleged "Reasons Relied On For Allowance Of Writ" (stated on page 14 of the petition) are all ground-

less, and that positive reasons of controlling weight have been specified conclusively showing why the prayed for writ should not be granted.

Therefore, the respondents respectfully pray that the said petition be denied.

Dated July 19, 1934.

E. H. SNOW, AND E. H. SNOW DOING
BUSINESS AS SNOW'S HATCHERIES
AND SNOW'S INCUBATOR COMPANY,
Respondents.

BY JAMES F. WILLIAMSON,
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APPENDIX.

Prior Adjudications of the Smith Patent 1,262,860, Identified.

Buckeye Incubator Co. & Samuel B. Smith vs. Bert W. Boling, Trading as the Brownstown Poultry Farm, at Brownstown, Indiana:

This was Equity case 812 in the U. S. District Court for the District of Indiana, Indianapolis Division. The case was tried before district judge Thomas W. Slick in January, 1926, who dismissed the plaintiff's bill of complaint for non-infringement in a decree signed and filed by him February 8, 1926, and which became final. This case was not reported but is referred to in the decision of district judge Hough in a later case entitled, *Boling vs. Buckeye Incubator Co., et al.,* D. C. S. D. Ohio, May 18, 1929, reported in 33 F. R. (2) 347, wherein the structure and mode of operation of the Boling incubator involved in said Indiana case, was described on pages 340-351 of judge Hough's decision.

Buckeye Incubator Co., et al. vs. Wolf, D. C. N. D. Ohio, May 9, 1923, 291 F. R. 253:

Two of Smith's patents were sued upon, including the one numbered 1,262,860 and all the claims thereof were in issue and were held to be valid and infringed, but said judge Westenhaver made no effort to determine the exact meaning and scope of the relied-upon claims, but, on the contrary, on page 256 of his decision made the following statement, to-wit:

"The claims need not be specifically stated. No question of invention or infringement turns on a close construction of all or any of the claims."

Wolf vs. Buckeye Incubator Co., et al., C. C. A. 6th, March 4th and April 11th, 1924, 296 F. R. 680:

> The decree of the trial court by judge Westenhaver was affirmed without any effort on the part of the Circuit Court of Appeals to determine the exact meaning and scope of the relied-upon claims 1 and 2 of the Smith patent.

Buckeye Incubator Co. vs. Cooley, D. C. N. J., Apr. 23rd, 1925:

> The decision of the trial court in this case was rendered by district judge Bodine but has not been reported. The method claims of the Smith patent 1,262,860, were in issue and held valid and infringed, but no effort was made to determine the exact meaning and scope of said claims.

Buckeye Incubator Co., et al. vs. Cooley, C. C. A. 3rd, Feb. 8th, 1927, 17 F. R. (2) 453:

> The trial court was here affirmed as to the validity and infringement of the method claims 1, 2 and 3 of the Smith patent 1,262,860, but no effort was made to determine the exact meaning and scope of said claims. The decision of said Circuit Court of Appeals was written by circuit judge Wooley, who also wrote the decision of said Court in the Hillpot case, 24 F. R. (2) 341, and, in the first sentence of the third paragraph on page 342 of that decision, made the following remark in respect to the Cooley case, to-wit:
>
> > "In the Cooley case, infringement was so plain there was no occasion to construe the claims."

A similar remark, applying both to the Wolf case and the Cooley case was made by judge Westenhaver in his

decision in the Blum case, 17 F. R. (2) 456, wherein on page 457, he made the following statement (italics ours):

> "Defendant uses an incubator known as the Aero, made by the Aero Incubator Company, Springfield, Ohio. The question in this case is whether the hatching method of this apparatus is an infringement. It is an open question now to be determined *for the first time.* In the former litigation, the apparatus held to infringe was an exact copy of Smith and it was unnecessary to determine with exactness the scope of the method claims. It was then said: 'No question of invention or infringement turns on a close construction of all or any of the three claims.'"

Buckeye Incubator Co., et al. vs. Petersime, et al., D. C. S. D. Ohio, Western Div.:

In this case, an oral decision was rendered by district judge Hickenlooper, June 30th, 1926, and a written memorandum thereof was approved Sept. 17, 1926. This decision is not reported but a copy thereof appears on pencil numbered pages 43 to 48, inclusive, of the Book of Decisions submitted to the trial court and to the Circuit Court of Appeals for the 8th Circuit in the instant case. In judge Hickenlooper's decision, it is not specifically stated which claims of the Smith patent were relied upon but in the decision of the C. C. A. for the 6th Circuit, 19 F. R. (2) 721, it is stated that the method claims 1, 2 and 3 were in issue.

Judge Hickenlooper made an extensive review of the prior art then before him and indicated that, in his judgment, Smith had made no contribution to that art involving patentable invention, but being constrained by a

prior decision of the Circuit Court of Appeals for the same Circuit, he treated the said claims as valid, but held, that when distinguished from the prior art the claims in issue were of narrow scope and distinguished from the method of hatching eggs practiced by defendant in that case and dismissed the bill for non-infringement. In the next to the last paragraph of judge Hickenlooper's decision, he made the following statement:

"* * * the patentee has voluntarily, and apparently, with reliance upon the idea that it was a marked step forward, included in each of his process claims the element of sequence in which the heated air would be applied to the eggs, first, to those of the most advanced stage of incubation, and last to those just placed in the incubator.

This element of the process is entirely lacking in defendant's device. There is no definite defined sequence of applying the air currents; the eggs are all in one chamber in which the air is thoroughly mixed and the heat is applied uniformly alike to all stages of incubation.

Under those circumstances we are constrained to hold whether viewed as a combination patent or as a process that there is no infringement."

Buckeye Incubator Co., et al. vs. Petersime, et al., C. C. A. 6th, June 10th, 1927, 19 F. R. (2) 721:

The hearing was before circuit judges Dennison, Moorman and Knappen. Circuit judge Moorman wrote the decision. In said decision the said Circuit Court of Appeals for the 6th Circuit did carefully consider and construe the method claims 1, 2 and 3 of said Smith pat-

ent and affirmed the trial court. In said decision said Circuit Court of Appeals pointed out the differences between the three method claims in issue and then, respecting claim 1, made the following statement:

> "It is thus to be seen that all of the claims call for a current of heated air limited in claims 2 and 3 to power-driven and vertically directed. The question is whether the broader phrase of claim 1, 'applying a current of heated air' includes the agitation of air, not in defined currents but so that it will produce a diffusion of heat units resulting in uniformity of temperature.
>
> Looking to the language of the claims, as indeed to the device that Smith uses, it would seem that he had in mind a process by which the warm air taken into the corridor would be currently directed, so as to strike first the eggs in the more advanced incubation, take to them the additionally needed oxygen, and carry the heat units therefrom to other parts of the two compartments, thus effecting in part, at least, a uniformity of temperature throughout the egg chambers. This interpretation, we think, is borne out by the specification."

Then after making some specific references to the specification of the Smith patent, the said Circuit Court of Appeals made the following statements:

> "The file wrapper history of Smith's patent tends to support the same conclusion. This conception of a current of air driven in a definite or predetermined direction is different, we think, from the Petersime process, by which diffusion of heat units and uniformi-

ty of temperature is obtained by the slow stirring or agitation of the air in the egg chamber.

Judgment affirmed."

Buckeye Incubator Co., et al. vs. Blum, D. C. N. D. Ohio, Feb. 14, 1927, 17 F. R. (2d) 456:

The decision was written by district judge Westenhaver. Claims 1 and 2 of the Smith patent 1,262,860 were held valid, but to be of such narrow scope, when distinguished from the prior art and the estoppels arising from the file wrapper record that they were not infringed by the defendant's method of hatching eggs and the bill of complaint was dismissed.

Buckeye Incubator Co., et al. vs. Blum, C. C. A. 6th, July 6, 1928, 27 F. R. (2d) 333:

The hearing was before circuit judges Dennison and Moorman and district judge Anderson. The trial court's holding of infringement was affirmed on the single ground that in the usage of the Blum machine Smith's current was not employed. Said C. C. A. did not pass on the question whether the other ground stated by the trial court was present or not.

Buckeye Incubator Co., et al. vs. Hillpot, D. C. D. N. J., Aug. 4, 1927, 22 F. R. (2) 855. Decision by district judge Bodine:

Claims 1 and 2 of Smith patent 1,262,860 were in issue and held to be of narrow scope when distinguished from the prior art and the estoppels arising from the file wrapper record and although treated as valid, were held not infringed by the defendant's method of hatching eggs and plaintiff's bill was dismissed.

Buckeye Incubator Co., et al. vs. Hillpot, C. C. A. 3rd, Feb. 10, 1928, 24 F. R. (2) 341:

> The hearing was before circuit judges Buffington, Wooley and Davis. The opinion was written by circuit judge Wooley. Careful independent effort was made to determine the true meaning of the method claims of said Smith patent and the trial court was affirmed.

Buckeye Incubator Co., et al. vs. F. & H. Hatchery, et al., D. C. S. D. Illinois, Nov. 30, 1928. Unreported:

> In this suit the patent was declared not infringed. Defendant in the suit had purchased incubators from the patentee's licensee and had merely increased the capacity of these incubators.

Boling vs. Buckeye Incubator Co., et al., D. C. S. D. Ohio, Western Div., May 18th, 1929, 33 F. R. (2) 347:

> This was a suit to restrain the defendants from bringing suits against plaintiff's customers in view of the prior adjudication in the Indiana case identified at the head of this list, and the prayed-for injunction was granted. The structure of the Boling incubator involved in the said Indiana case is described on pages 350 and 351 of this decision.

Buckeye Incubator Co. and Samuel B. Smith, Appellants, vs. Bert W. Boling, Appellee, C. C. A. 6th, Feb. 13, 1931, 46 F. R. (2) 925:

> The trial court reversed as to injunction and injunction dissolved.

Buckeye Incubator Co. & Samuel B. Smith vs. Miller Hatcheries, Inc., D. C. E. D. Mo., March 6, 1929:

> This case is not reported in the Federal Reporter but a copy of the decision appears on pages 83-87 of the Book

of Decisions hitherto referred to. All of the claims of the Smith patents 1,262,860 and 1,263,138 were in issue and held valid and infringed. Defendant's machines in that case, however, were simply original Smith machines which had been modified to get increased capacity and the trial court held this was not a matter of legitimate repairs but a reorganization in accordance with the Smith patent.

Miller's Hatcheries, Inc., et al. vs. Buckeye Incubator Co., et al., C. C. A. 8th, May 19th, 1930, 41 F. R. (2) 619:

The hearing was before circuit judges Booth and Gardner and district judge Sanborn. The decision was written by judge Booth. The trial court was affirmed. Under the Doctrine of Comity, the claims in issue were treated as valid because of the prior adjudications thereof and no attempt, whatever, was made to determine and state the exact meanings and scope of claims 1 and 2 of the Smith patent 1,262,860 in suit.

Samuel B. Smith and Buckeye Incubator Co. vs. Herbert A. Waxham, Doing Business as the Waxham Hatcheries, D. C. S. D. Cal., Central Division, June 30, 1932.

Claims 1 and 2 of the Smith patent 1,262,860 were held valid and infringed.

The case was not reported in the Federal Reporter or Supplement, but it appears on pencil pages 107 to 126 of the Book of Decisions hitherto referred to.

The case was tried before a master and his reports do not indicate on their faces that the entire prior art essential for consideration was before him or that he had given any due consideration to the estoppels arising from the file wrapper record of the Smith patent.

The district judge, Paul J. McCormick, approved the master's report in his order of June 30, 1932, but admitted therein that the question of infringement was a close one. His own words on that point are as follows:

> "The only debatable issue here is that of infringement because of the limitation as to order of eggs within the incubator under a proper interpretation of claim 1 of the Smith patent 1,262,860. *I believe this question to be close.*"

Samuel B. Smith and Buckeye Incubator Co. vs. Jensma, Smith & Nampa Hatcheries, D. C. Idaho, Oct. 7, 1931, Vol. 1, Federal Supplement, p. 999:

> Claims 1 and 2 of the Smith patent 1,262,860 were here held valid and infringed; but no attempt was made to determine the true meaning of said claims when distinguished from the prior art and the estoppels arising from the file wrapper record of the patent. The second paragraph of the said decision includes statements to the following effect (italics ours), to-wit:
>
> "* * * the issue of non-infringement is presented by the pleadings under the claims sued on. *No evidence was offered by the defendants* to refute the undisputed testimony of the plaintiffs, which clearly shows that the defendants have made and are using incubators embodying the inventions shown in plaintiff's patent, particularly, claims one and two thereof, in infringement of its rights."
>
> Then the last paragraph of said decision reads as follows (italics ours):
>
> "*No accounting for profits or awards for damages* are requested by the plaintiffs as they were waived at

the trial and the relief granted is the prayer of plaintiffs for an injunction."

From said quoted statements it is perfectly obvious that this was really not a contested case, but a case conducted practically with the consent of both parties for what amounts simply to a consent decree. It has the earmarks of a collusive suit. Obviously it has no weight as to the meaning and scope of claim 1 of the Smith patent 1,262,860 there in suit.